

## **REMARKS/ARGUMENTS**

Applicant notes with thanks and appreciation the Examiner's indication of allowable subject matter in claim 9. Regarding the rejections of claims 1-3, 5, 7, and 10-37, Applicant respectfully requests reconsideration and continued examination of this application in view of the above amendments and the following remarks.

### **1. Status of the Claims**

Claims 1-3, 5, 7, and 9-38 are pending in this application.

Claims 1, 2, 14, 15, 17, 18, 20, 35, and 36 have been amended to further clarify the claimed devices and methods.

New claims 38-42 have been added to recite additional structure and functionality of the recited cap.

Support for these amendments is found, for example, in Figures 1, 2, 4 and 5; page 8, lines 15 and 16; and page 10, lines 20-31 of the original specification.

### **2. Objection to the Drawings**

The Examiner has requested corrected drawings to show the visual indicator angularly spaced apart 120° from the air passage and the strand angularly spaced apart 120° or 90° from the spout. This objection is apparently an oversight, as a new sheet of drawings showing these embodiments was already submitted and entered in the application in March 2010, meeting this request and successfully overcoming the Examiner's objection at that time. This objection should therefore be withdrawn.

### **3. Claim Rejections Under 35 U.S.C. § 112**

Claims 14-17, 28, 31 and 36 were rejected under § 112, second paragraph for allegedly failing to point out and distinctly claim the subject matter which Applicant regards as the invention.

Regarding claims 14-17, 28, and 31, Applicant respectfully traverses this rejection, noting that, as the Examiner has previously acknowledged, claim 1 only

requires that the pouring device be adapted to permit sealing by a suitable cap, so that claims 14-17, 28, and 31 further limit claim 1 by actually requiring that such a cap be included with the pouring device. In particular, the Examiner previously stated in the Office Action dated February 27, 2009:

The reject[ion] under 35 U.S.C. § 112 has been withdrawn in view of applicant's arguments. Furthermore, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re [Hutchison]*, 69 U.S.P.Q. 138. In this respect the cap is not positively recited.

The Examiner has not provided any explanation for the reinstatement of the objection that was previously withdrawn for the reasons stated in the above quotation.

Additionally, Applicant respectfully traverses the Examiner's objection that the recitation that a pouring device is adapted to permit sealing by a cap in claim 1 is not a positive limitation. Indeed, the Examiner recognizes that such a recitation "requires the ability to so perform," thereby implicitly recognizing that the objected to recitation is by definition a limitation, as it narrows the claim by *excluding* pouring devices that *lack* the ability to so perform, i.e., to be sealed by a suitable cap from the scope of the claim.

Nor does *Hutchison* apply to the precise language of claim 1, namely, "adapted to permit sealing the liquid in the bottle from the atmosphere by a cylindrical longitudinal extent of a cap insertable into the interior of the upper portion to close both the apertures of the filter and the air passageway to the atmosphere." Unlike the language of claim 42 of the patent in suit in *Hutchison*, "*adapted for use in the fabrication of a metal template or the like suitable for metal-working operations*," (court's emphasis), which merely specifies a field of intended use for the claimed article of manufacture as a whole, the language of claim 1 is a particular limitation on the shape of the device, excluding devices whose shape does not permit sealing by a cylindrical longitudinal extent of a cap. For example, a pouring device such as Jiang, having an obstruction that would prevent any cylindrical longitudinal extent of a cap from being sufficiently inserted

into the device to seal the device, is excluded from the scope of claim 1. In this respect, the limitation of claim 1 of the present invention is clearly more similar to that of claim 58 of the patent in suit in *Hutchison*, "*adapted to be adhered to a metal backing element*" *Hutchison*, 69 U.S.P.Q. at 140 (court's emphasis). The court did not state that this language of claim 58 was not a positive limitation, although it found claim 58 to be "specific only to photographic paper *coated with adhesive, the metal plate . . .* being 'mentioned inferentially' and *not positively included as an element.*" *Id.* at 141 (emphasis added). Similarly, although the limitation in claim 1 of the present application limits the shape of the claimed device as being adapted to permit sealing by a suitable cap, the cap itself is not positively included as an element.

For at least the foregoing reasons, the limitation in claim 1 is a positive claim limitation in the patentable sense but does not positively recite that the device includes a cap. Therefore, the rejection should be withdrawn.

With respect to claim 36, the positive recital of a plurality of circumferential sealing rings in claim 36 is strictly narrower than the positive recital of "a" (i.e., one or more) sealing ring in claim 35. Thus, the plurality of sealing rings in claim 36 is not a double inclusion of the sealing ring of claim 35. Additionally, claim 36 further limits claim 35, claim 35 has been amended to recite a first and claim 36 to recite a second sealing ring. In view of the foregoing, Applicant respectfully requests that the rejection be withdrawn.

#### **4. Claim Rejections Under 35 U.S.C. § 103(a)**

Claims 1-3, 5, 7, 10-16, 18-25, 29, 30, 32 and 35 are rejected under 35 U.S.C. § 103 as being obvious over U.S. Patent No. 4,637,530 to Jiang ("Jiang") in view of U.S. Patent No. 5,228,603 to Pham et al. ("Pham"). Claims 17, 28 and 31 are rejected as being obvious over Jiang and Pham in view of U.S. Patent No. 4,345,704 to Boughton ("Boughton"). Claims 26 and 27 are rejected as being obvious over Jiang and Pham in view of U.S. Patent No. 3,307,752 to Anderson ("Anderson") and U.S. Patent No. 4,347,946 to Nichols ("Nichols"). Claims 33-37 are rejected as being obvious over Jiang and Pham in view of U.S. Patent No. 5,417,860 to Kay ("Kay").

a) 103(a) Rejections over Jiang in view of Pham

Claims 1-3, 5, 7, 10-16, 18-25, 29, 30, 32 and 35 have been rejected under 35 U.S.C. § 103(a) as obvious over Jiang in view of Pham. Applicant respectfully traverses this rejection. Applicant responds by addressing the points presented by the Examiner in the Response to Arguments section.

The Examiner first addresses Applicant's argument that the following elements of claim 1 are not found in or suggested by Jiang and Pham:

a filter including a pour opening composed of a plurality of substantially uniformly disposed apertures, the pour opening extending across substantially an entire substantially circular cross section of the cylindrical body;

an air passageway disposed adjacent to the internal periphery of said lower portion and extending longitudinally beyond the length of said lower portion in a direction away from said upper portion along the internal periphery of said cylindrical body, a portion of the air passageway being integrally formed with and at least coextensive with said filter in the longitudinal direction;

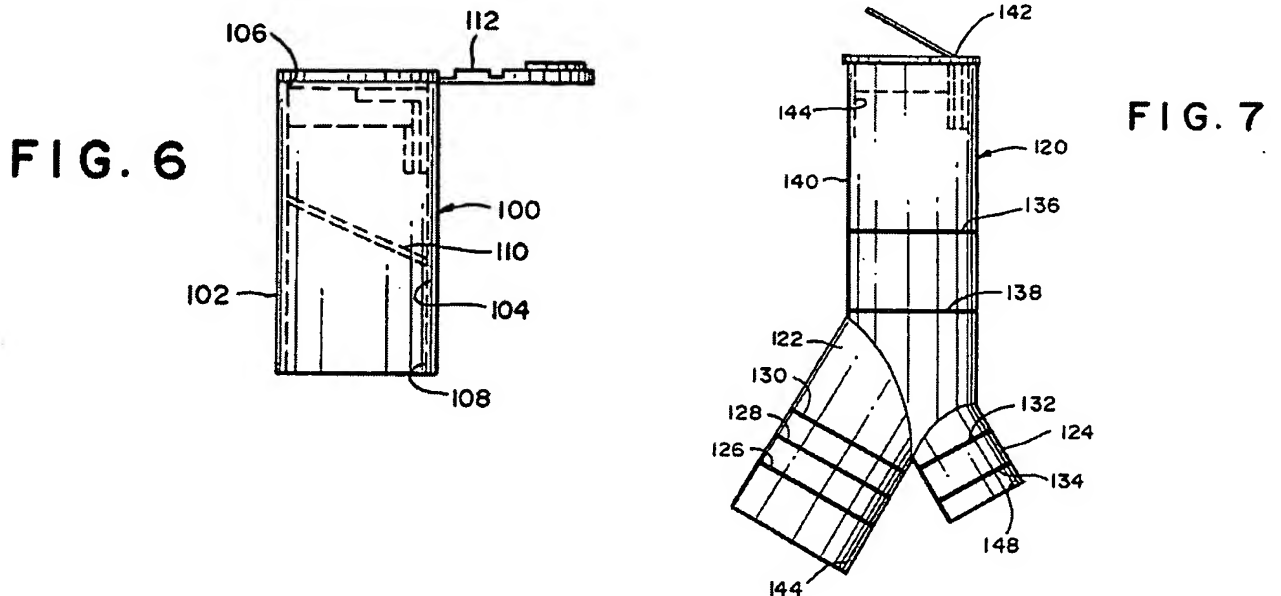
With regard to these elements, the Examiner reasons that both Jiang and Pham show "vent openings 8 and 48 within a perimeter defined by . . . the respective upper portions of the spouts [sic, pouring devices]<sup>1</sup> and next to the pouring openings and the perimeter of the spout [sic, pouring device] encircling the filter element." This reasoning, even if correct, is irrelevant to the claim limitations in question, which expressly require that the apertures of the filter substantially encircle the air passageway, an aspect of the invention that is not found in either Jiang or Pham.

As for the entire device of Pham being "integrally formed" and "coextensive," what is meant by "integrally formed" is specifically that the air passageway and the filter form part of a single, unitary body, and what is meant

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<sup>1</sup> To avoid any potential for inadvertent miscommunication on the part of either the Examiner or Applicant when using terms from the claims in an informal sense, the term "spout" as used in the present claims does not refer to the entire pouring device, but only to a feature included in the pouring device. The spout feature may serve, for example, both as a pouring outlet that prevents dripping and to visually indicate a preferred orientation for pouring (i.e., tilting a container in which the device is inserted towards the spout side of the device, and thus away from the air passageway side of the device, which is opposite the spout side of the device). See, e.g., Fig. 2, item 31; p. 9, Ins. 16-20 of the application as filed.

by "coextensive . . . in the longitudinal direction" is specifically that the air passageway overlaps the entire longitudinal length (i.e. the vertical dimension of the filter as seen in Figures 5 and 6 of the present application) of the filter. The relevant claims have been amended to clarify these features, which are not disclosed in or suggested by Pham, Jiang, or the two in combination. In particular, the air passageway of the Pham device, as illustrated in Pham Figures 6 and 7 reproduced below, is wholly separate from and longitudinally spaced apart from (as opposed to longitudinally overlapping) screens 110, 136.



Next, with respect to the limitation of claim 1,

the cylindrical body extending above and surrounding the uniformly disposed apertures and the air passageway such that the upper portion is adapted to permit sealing the liquid in the bottle from the atmosphere by a *cylindrical* longitudinal extent of a cap;

(emphasis added) the Examiner refers to "applicant's arguments that it would be impossible to make a cap capable of sealing the spout [sic, pouring device] of Jiang," responding that "a cap can be molded or formed with a complementary shape" including a recess to mate with the element 5a of Jiang. See Jiang Figs. 2 and 3, reproduced below.

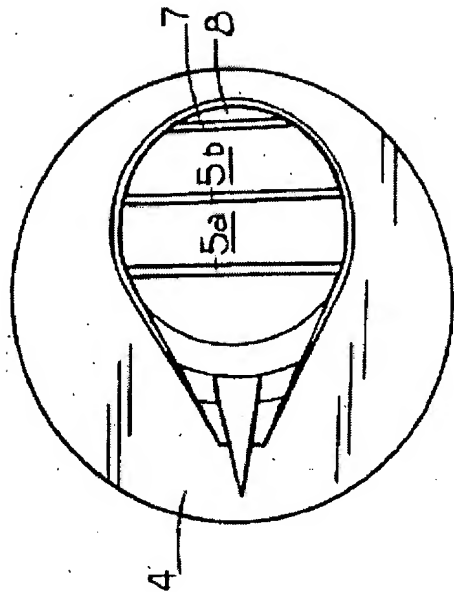


FIG. 3

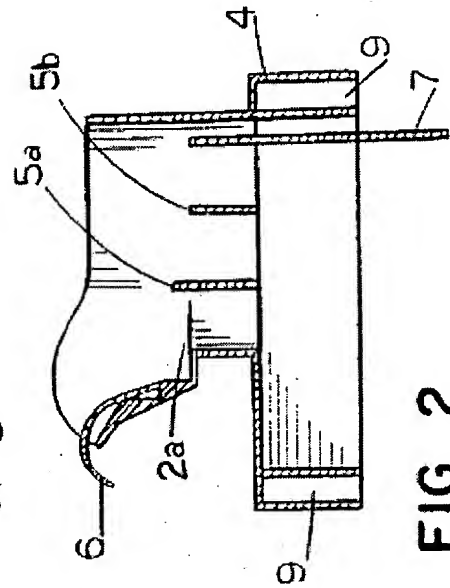


FIG. 2

In fact, this is Applicant's argument, which is not that sealing the device of Jiang would be impossible, but rather that any insertable longitudinal extent of a cap that would seal the device of Jiang would have to include such a complementary shape to accommodate element 5a, and therefore would not be cylindrical in accordance with the claim. In addition, the Examiner states that recess 158 disclosed in the cap of Pham "does not change the external sealing profile of the cap." See Pham Figs. 8 and 9, reproduced below:

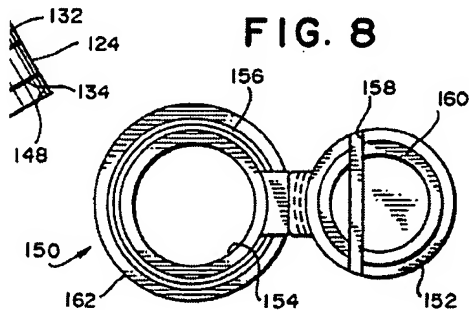


FIG. 8

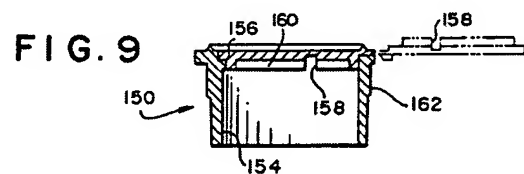
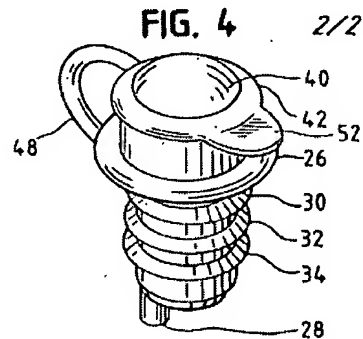
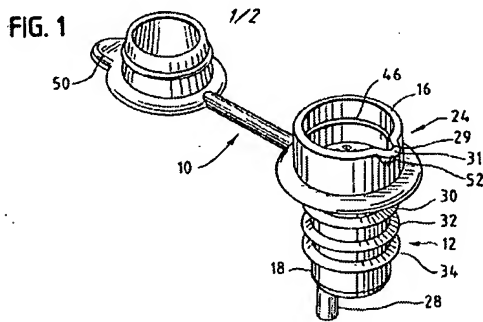


FIG. 9

Applicant disputes this premise, as recess 158 does change the external sealing profile of the cap, in particular, by defining two significant gaps in its perimeter at

each end of recess 158. Thus, the insertable portion of the cap is rendered non-cylindrical and therefore outside the scope of the rejected claims.

Finally, the Examiner argues that Pham shows the pouring device having an "upper ring [sic, rim]" that is horizontally coplanar with an upper rim of a spout so that the spout can be sealed by a horizontal tab of a cap. Pham does not show the device having a spout at all, as the term "spout" is used in the application, let alone a spout having a horizontally planar upper rim as in claim 30 or that is coplanar with an upper (second) end of the device as in new claim 38 and as illustrated in Figures 1 and 4 of the present application, reproduced below.



Note that second end 16 is coplanar with the rim of spout 31, and circumferential shoulder 42 is coplanar with tab 50. Pham does not disclose or suggest such a device, as recited in either of claims 30 and 38. Moreover, the spout of Jiang is not horizontally planar, but includes curvature in the vertical directions as seen in profile in Jiang Figure 2, in addition to the tongue member 6, which would further prevent covering the spout of Jiang to the atmosphere with a horizontally planar tab.

For at least the foregoing reasons, the rejected claims are patentable over Jiang in view of Pham.

b) Rejections over Jiang in view of Pham and further in view of Boughton  
Claims 17, 28 and 31 are rejected as being obvious over Jiang and Pham  
in further view of Boughton.

Boughton has been relied on only as disclosing a strand having a circular cross-sectional shape connecting a cap to a pouring device. Boughton fails to supply the deficiencies of Jiang and Pham with respect to the independent claims, as discussed above. Thus, for at least the reasons discussed above, the present invention is patentable over Jiang and Pham in further view of Boughton.

In addition, claim 14 and claims dependent therefrom (claims 17, 28, 31 and 39-42) recite that the cap is attached to the upper portion of the cylindrical body by a flexible strand of material. The flexible strand of material extends from the upper portion and provides the visual indication recited in claim 1 for identifying the relative angular location of the air passageway. This structure and arrangement is not taught or suggested by any combination of the cited references.

Consequently, claims 17, 28, 31 and 39-42 are patentable.

Furthermore, Boughton, which discloses a non- integral ring and band 32 to secure the cap to the bottle, has no air passageway, let alone an air passageway associated with a lower cylindrical section that is insertable into a bottle. For these additional reasons, claims 39 and 40 are also patentable.

c) Rejections over Jiang in view of Pham and further in view of Anderson and Nichols

Claims 26 and 27 are rejected as being obvious over Jiang and Pham in further view Anderson and Nichols. Anderson and Nichols are only relied on as disclosing caps attached to a pouring device that include strands disposed 90° and 120° from a pouring spout, respectively. Neither Anderson nor Nichols supplies the deficiencies of Jiang and Pham discussed above with respect to the independent claims. Thus, for at least the reasons discussed above, the present invention is patentable over Pham and Jiang in further view of Anderson and Nichols.




d) Rejections over Jiang in view of Pham and further in view of Kay

Claims 33-37 are rejected as being obvious over Jiang and Pham in further view of Kay. Kay is only relied on as disclosing a bottle filter and pouring device that is formed by injection molding. Kay fails to supply the deficiencies of Jiang and Pham discussed above with respect to the independent claims. Thus, for at least the reasons discussed above, the present invention is patentable over Jiang and Pham in further view of Kay.

### **CONCLUSION**

In view of the foregoing, no single reference or combination of the cited references teaches, suggests or otherwise renders obvious the subject matter of claims 1-3, 5, 7, and 10-37. Applicant respectfully submits that all of the rejections have thus been overcome and claims 1-3, 5, 7, and 9-37, as amended, and new claims 38-42 are in condition for allowance. Accordingly, an early indication of allowance is solicited.

Respectfully submitted,

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